

REMARKS

Claims 1-26 are pending in the application. Claims 1, 19, 21 and 22 have been amended. Reconsideration of this application is respectfully requested.

The Office Action rejects claims 1-9, 12, 13, 16 and 19-25 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 6,525,749 to Moran et al., hereafter Moran in view of U.S Patent No. 4,430,526 to Brown et al., hereafter Brown.

Claims 1, 19, 21 and 22 have been amended to clarify that information entered via an electronic pen input device is selectively routed to entirely different devices, namely the controller and the computing device, based on manipulation of the pen. Thus, claim 1 has been amended to recite that the controller not only interprets the emitted signal as handwriting information or as control information, but also routes the handwriting information for storage in the controller and routes the control information to the computing device. Method claim 19 has been amended by adding a routing step with language similar to claim 1. Storage medium claim 21 has been amended to recite that the program instructions not only interpret the emitted signal as handwriting information or as control information, but also routes the handwriting information for storage in the controller and routes the control information to the computing device. Claim 22 has been amended to recite that the controller routes to the input device the information to be stored therein and to the computing device the information to be forwarded thereto.

Neither Brown nor Moran teaches the combination of an electronic pen input device, a controller and a computing device as claimed in claims 1, 19, 21 and 22. This claimed combination provides a unique functionality. When a first tip of the pen is selected by user manipulation only the controller is active for storage of handwriting information and the computing device need not be active.

This cuts down greatly on total system power when the user is writing. When the second tip is selected, the control information (e.g., pen position) is routed to the computing device. In this mode the total system power is greater, but the user is able to access the resources of the more powerful computing device. This functionality is distinctly different from the functionality that could be achieved by the combination of Moran and Brown, which at best would give one the ability to change the mode (such as an erase function) of a single device. In contrast, the claimed invention does not just change the mode of inking or control as would be achievable from the combination of Moran and Brown, but rather changes the destination of the pen position information to two entirely separate locations, namely, handwriting information to the controller and control information to the computing device. Thus, the handwriting is stored in the controller's flash memory at very low power, while the control information is forwarded to the entirely distinct computing device that only needs power when the non-inking tip is selected.

Neither Moran nor Brown discloses or teaches a controller, method steps or program instructions that interpret the emitted signal based on the tip of the input pen that is used and that route the information thereof to the input device or the computing device. The combination of Moran and Brown has no selective interpretation of the information as handwriting information for storage in a controller or as information for the computing device. There is no routing of the information to either the controller or to the computing device as recited in amended claims 1, 19, 21 and 22. For this reason, the rejection does not apply to these claims.

For the reason set forth above, it is submitted that the rejection of claims 1-9, 12, 13, 16 and 19-25 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 10 and 11 under 35 U.S.C 103(a) as unpatentable over Moran in view of Brown as applied to claim 1, and further in view of U.S. Patent No. 6,441,810 to Skoog et al., hereafter Skoog.

This rejection is inapplicable to claims 10 and 11 for the same reasons set forth above in the discussion of their parent claim 1.

For the reason set forth above, it is submitted that the rejection of claims 10 and 11 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 14 and 15 under 35 U.S.C 103(a) as unpatentable over Moran in view of Brown as applied to claim 1, and further in view of U.S. Patent No. 6,415,240 to Kobayashi et al., hereafter Kobayashi.

This rejection is inapplicable to claims 14 and 15 for the same reasons set forth above in the discussion of their parent claim 1.

For the reason set forth above, it is submitted that the rejection of claims 14 and 15 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 17 and 26 under 35 U.S.C 103(a) as unpatentable over Moran in view of Brown as applied to claim 1, and further in view of U.S. Patent No. 6,417,844 to Kodama, hereafter Kodama.

This rejection is inapplicable to claims 17 and 26 for the same reasons set forth above in the discussion of their parent claims 1 and 22.

For the reason set forth above, it is submitted that the rejection of claims 17 and 26 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claim 18 under 35 U.S.C 103(a) as unpatentable over Moran in view of Brown as applied to claim 1, and further in view of U.S. Patent No. 5,963,199 to Kato et al., hereafter Kato.

This rejection is inapplicable to claim 18 for the same reasons set forth above in the discussion of their parent claim 1.

Moreover, the Office Action admits that neither Moran nor Brown uses a paper medium, but contends that Kato does and that it would be obvious to replace Moran's LCD display with paper medium of Kato. This contention is untenable because there is a world of difference between Moran's LCD and Kato's paper medium. This distinction is important because it is not be apparent to one of ordinary skill in the art to use a flip pen system with both an "inking tip" in "non-inking tip" in Moran since everything the user writes in Moran's system is dynamically displayed and updated graphically on an LCD. For example, the user can insert or delete regions of text on the screen with gestures because the changes are immediately updated on the system LCD. With an "inking-tip" on paper the functionality described by Moran is not possible. For example, once an inking tip is put to paper, a mark is made that can not be dynamically changed by Moran's system. Kato's system cannot move the user's ink representations in the way described by Moran since they would be written in ink on paper. Again, a sheet of paper is an important difference from Moran's LCD, because the paper has physical characteristics, which are changed by the act of writing, and which cannot be dynamically updated in response to gestures in the same way as Moran's LCD. A drawback of Moran's system is that the LCD used is expensive and requires a lot of battery power. Accordingly, there is no motivation for one of ordinary skill in the art to combine Moran and Brown with Kato.

The Office Action suggestion to use the paper medium of Kato in combination with Moran and Brown is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the

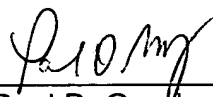
basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claim 18 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 103(a) be withdrawn, that claims 1-26 be allowed and that this application be passed to issue.

Respectfully Submitted,

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